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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,702	09/07/2004	Michael J Breslin	21047YP	3343
210	7590	07/01/2008	EXAMINER	
MERCK AND CO., INC			HAVLIN, ROBERT H	
P O BOX 2000				
RAHWAY, NJ 07065-0907			ART UNIT	PAPER NUMBER
			1626	
			MAIL DATE	DELIVERY MODE
			07/01/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/506,702	BRESLIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	ROBERT HAVLIN	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 March 2008.
- 2a) This action is **FINAL**.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 3,4,6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 3,4,8 and 10 is/are rejected.
- 7) Claim(s) 3,4,6 and 8-10 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

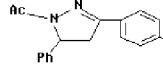
Claims 3, 4, 6, and 8-10 are currently pending. Claims 1, 2, 5, 7, 11-36 were previously cancelled.

## RESPONSE TO APPLICANT REMARKS

### *Claim Rejections - 35 USC § 102*

1. Claims 3, 4, and 10 were rejected under 35 U.S.C. 102(b) as being anticipated by Mishriky et al. (CAPLUS Abstract (accession #1988:570299) of Egyptian Journal of Chemistry (1987), Volume Date 1986, 29(2), 241-6).

**This rejection is withdrawn** because applicant has amended the claims to avoid the reference by requiring two substitutions on the R2 phenyl whereas the cited prior art

only has a single substitution in the species  of Mishriky et al. as applicant pointed out.

### *Claim Objections*

2. Claims 4, 8, and 10 were objected to as being dependent on a rejected base claim. Claims 4, 6, 8-10 were objected to for reading on non-elected subject matter in view of the restriction to the scope of the elected species. **These objections are maintained** because of the following new rejections.

## NEW REJECTIONS

### *Claim Rejections - 35 USC § 102*

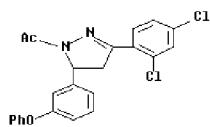
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 3, 4, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Pavagadhi et al. (CAPLUS Abstract of Pavagadhi et al., Journal of the Institution of Chemists (India) (2001), 73(3), 97-98. Accession # 2002:199098.).

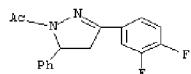
The reference teaches the following compound which anticipates the claims as follows:



R1 is (C=O)CH<sub>3</sub>; R2 is 2,4-dichlorophenyl; R3 and R4 are hydrogen; R5 is hydrogen; R6 is 3-phenoxyphenyl.

5. Claims 3, 4, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Joshi et al. (CAPLUS Abstract of Joshi et al., Journal of the Indian Chemical Society (1984), 61(11-12), 1014-15. Accession # 1986:34035.).

The reference teaches the following compound which anticipates the claims as follows:



R1 is (C=O)CH<sub>3</sub>; R2 is 3,4-difluorophenyl; R3 and R4 are hydrogen; R5 is hydrogen; R6 is phenyl.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 3, 4, 8, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims were amended to claim a new subgenus of compounds which does not have support in the original specification. Specifically, the requirement of two substitutions on the R2 phenyl ring was not previously disclosed in the specification and there is insufficient support for the entire new subgenus. The new matter part of the claims is shown below:

R<sup>2</sup> is phenyl;  
said phenyl is optionally substituted with two ~~one or more~~ substituents selected from  $(C=O)_aO_bC_4-C_{10}$  alkyl,  $(C=O)_aO_b$  aryl, CO<sub>2</sub>H, halo, or CN, ~~or~~ CHO;

### ***Conclusion***

No claims are in condition for allowance. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/  
Robert Havlin, Ph.D.  
Examiner  
Art Unit 1626

/Kamal A Saeed, Ph.D./  
Primary Examiner, Art Unit 1626

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